

## **Dispute Resolution Process Submission**

**From:** The International Trademark Association  
**Received:** 16 February 2005

The International Trademark Association (INTA) welcomes this opportunity to provide a response to DNC's Working Group Consultation Paper on the establishment of a dispute resolution process for the nzTLD.

INTA is a not-for-profit membership association of more than 4,500 trademark owners and professionals from more than 180 countries, including New Zealand. It is dedicated to the support and advance of trademarks and related intellectual property as elements of fair and effective national and international commerce. For the last ten years, INTA has also been the leading voice of trademark owners within the Internet community, serving as a founding member of the Intellectual Property Constituency of the Internet Corporation for Assigned Names and Numbers (ICANN). In addition, INTA has provided commentary to numerous ccTLD operators, including .ca (Canada), .ie (Ireland), .sg (Singapore), and .uk (United Kingdom), concerning registration and dispute resolution practices.

INTA supports the majority view of the Working Group, namely that a dispute resolution arbitration process should be established for the nzTLD. INTA recognizes that courts in New Zealand have been well equipped to effectively deal with trademark related domain name disputes which have come before them. However, as with the experience in other countries, all parties involved in a domain name dispute benefit greatly from a quick and cost effective arbitration system to deal with cases of bad faith domain name registrations.

The consultation paper has identified two options for a dispute resolution process namely:

1. A system based on the Nominet UK model; or
2. A modified ICANN Uniform Dispute Resolution (UDRP) model.

The paper clearly identifies advantages and disadvantages of both models. However, the paper at times appears to assume that the form of the rules adopted dictates the organization that that will run the dispute resolution process. We believe that greater flexibility exists. For example, the section dealing with disadvantages of the UDRP appears to assume that it is necessary to utilize the WIPO Arbitration and Mediation Centre and hence WIPO panellists. INTA wishes to highlight that the DNC may appoint its own arbiters outside the WIPO centre. As such, many of the stated disadvantages or concerns of the UDRP model may be avoided. Moreover, further customizing to meet local conditions may be implemented. Conversely, WIPO is both willing and able to operate disputes resolution processes for domain names which differ from the UDRP.

In deciding which model to adopt, regard may be had to the experience of Australia, which introduced a modified UDRP type process in August 2002 - the auDRP (see <http://www.auda.org.au/policies/auda-2002-22/>). The auDRP was customized to take account of unique eligibility criteria applicable in .au and also to remedy a number of perceived ambiguities or uncertainties in the UDRP. (For example, the auDRP was amended to make it clear that registration or subsequent use in bad faith would be sufficient.) A similar approach could be adopted for .nz. By all accounts, the auDRP has been a success and has addressed the need for a cost effective and expedient means to resolve bad faith domain name registrations. Since adoption of the auDRP, 29 complaints have been filed.

INTA's view is that the UDRP is not radically different from the Nominet UK model for resolving domain name disputes. For example, both are expedited, relatively inexpensive systems in which expert arbitrators apply multi-factor tests to assess the presence or absence of bad faith. INTA would support the introduction of either model for the nzTLD. However, on balance, INTA's preference would be the adoption of a UDRP model. This model is likely to be more expedient and cost effective and, given that the number of disputes which is likely to be received is unlikely to be high, INTA questions whether the expense of setting up a Nominet type system would be warranted. In addition, INTA is a strong proponent of harmonization in the field of trademark law. The UDRP model has been adopted across numerous gTLDs and ccTLDs with great success and the requirements under the model are well understood by trademark owners and advisors worldwide.

INTA appreciates the opportunity to offer its comments concerning the dispute resolution procedure for the nzTLD. We look forward to answering any questions that DNC has with respect to our submission.

Sincerely,  
Michael E. Heltzer

External Relations Manager  
International Trademark Association